

REMARKS/ARGUMENTS

Claims 1-3 are pending in this application and have been rejected. Claim 3 has been cancelled. The drawings have been objected to, and corrected drawings with changes outlined in red have been submitted for review. The specification and claims have been objected to for several informalities. Claim 3 was rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Delanoy. Claims 1 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Delanoy.

Regarding the specification, though most of these informalities have been corrected by an amendment, the first informality cited by the Examiner stating "[o]n page 3, line 34, "40" should read -14—" has not been amended. On page 3, line 34, the specification states "a conventional vertical vent pipe 40 is located within the hollow wall 14." As seen in Fig. 1A, numeral 40 points to a vent pipe and 14 points to a hollow wall. Consequently, the Applicant does not believe the numeral 40 on page 3, line 34, should be changed to 14.

Claim 3 was rejected under 35 U.S.C. 112 as failing to comply with enabling requirement. Claim 3 has been cancelled and therefore this rejection should be withdrawn.

Regarding the claims, claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Delanoy. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others

requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 2 requires in part "[a] cap assembly threadably mounted on the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded onto the first end." The cap assembly to Delanoy discloses a cap assembly 6 within a trap 2. (See Figs. 2 and 4). Delanoy does not teach a cap assembly that is mounted on the first end of a pipe, instead Delanoy teaches a cap assembly threadably mounted within a pipe. Therefore, each and every limitation is not met and the anticipation rejection cannot stand.

In addition, the Examiner has rejected claims 1 and 3 under 35 U.S.C. 103(a) as being unpatentable over Lewis in

view of Delanoy. The Applicant respectfully disagrees. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher."

Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining

prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g. the overflow assembly of Lewis, combined with the cap membrane of Delanoy. To justify this combination the Examiner simply stated "[i]t would have been obvious to one of ordinary skill in the bathtub cap or test plug system art, at the time the invention was made, to provide the test plug or cap of Lewis

with a thin sealing membrane in view of the teachings of Delanoy in order to provide for an easy placing of the connections after the test has been applied." (Examiner's Answer, page 4). Rather than pointing to specific information in Delanoy that suggest the combination with the Lewis overflow and cap assembly, the Examiner described the general functions of an overflow assembly and cap assembly having a membrane. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. See, e.g., Pro-Mold & Tool, 75 F.3d 1568, 1573, 37 USPQ 2d 1626, 1630 (Fed. Cir. 1996).

To the contrary, the Examiner's decision is based on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention (Examiner's Answer, Page 4-5). Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Delanoy reference teaches or suggests its combination with Lewis to yield the claimed invention. For example, the Examiner has not explained why, if it was obvious to make the proposed combination, that the overflow and cap assembly of Lewis (2002) did not combine the plate of Delanoy (1917) when this option was readily available. In contrast, Lewis, as a person of ordinary skill in the art, chose to use a capture nut 21 in combination with a elongated test plug 8 to seal the overflow port instead of using a cap having a flexible thin membrane, as is set forth in independent claim 1 of Applicant's application. In this respect, Lewis teaches away

from the proposed combination. This is a point the Examiner did not address in the Office Action.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Here, because Lewis teaches the use of an elongated plug to seal an overflow pipe, one skilled in the art upon reading Lewis would have been led on a path divergent from that taken by Applicant.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Lewis which teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand.

Also, the combination of the prior art references does not lead to the invention as claimed. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art; not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 has been amended to require in part "a cap threadably mounted on an end of the horizontal leg extending through the overflow port, the cap having an opening in its circular planar end, with a thin flexible sealing membrane secured to the cap and extending over the opening in the circular planar end." The cap of Delanoy does not have a thin flexible sealing membrane. Instead Delanoy uses a plate 10 that is inflexible and must be broken away to be removed. (See Col. 2 lines 70-84). In addition, even if one could consider the plate in Delanoy a thin flexible sealing membrane, the combination of Delanoy and Lewis still does not result in Applicant's invention as claimed. Specifically, if the cap 6 and plate 10 of Delanoy were to be combined with the overflow assembly device of Lewis, the resulting combination would include an overflow assembly with a cap and plate that is threaded within the trap. Claim 1 requires that the cap be mounted "on" not "within" the drain pipe, as well as on an end of the horizontal leg [of the drain pipe] extending through the overflow port and not within the trap portion of the drain port. The only way that the references can be combined to arrive at the claimed invention is to impermissibly use the application as a blue print. Therefore, the combination of the plate of Delanoy with the overflow assembly and cap of Lewis does not disclose each and every limitation of the claimed invention. Consequently, a *prima facie* case of obviousness has not been provided and the 103 rejection should be withdrawn.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C.  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

- bjs/jlk -



Appl. No. 10/721,694  
Reply to Office Action of May 18, 2004  
Annotated Sheet Showing Changes

